

In item 1 on page 2 of the above-identified Office action, the Examiner stated that "[a]pplicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn". Also, the Examiner withdrew the rejections of claims 1-18.

In item 3 on pages 2-7 of the Office action, claims 1-18 have been rejected as being obvious over *Thum* (US 5,194,199) in view of *Russell* (WO 93/05103) under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 (similarly claim 15) calls for, inter alia:

coating a **solid core** material with activatable material;

enclosing the solid core material and the activatable material with an **outer plate** to form an assembly with a defined cavity inside said outer plate;

passing the assembly to a **corrosion** treatment bath and subjecting **all interior** areas of the assembly to a corrosion protection agent; and

subsequently passing the assembly to a drying oven for heating and, thereby, initiating foaming of the activatable material at least partly filling the defined cavity.

In the first paragraph on page 3 of the Office action, the Examiner stated:

As to claims 1, Thum teaches a method for producing a hollow section with internal reinforcement comprising: coating a solid core material with activatable material enclosed in a cavity (col. 2, lines 10-16)).

Thum states in col. 2, line 17-20, "the core ... is first provided with a shell of a material which is foamable" (col. 2, line 19-20)". The abstract on the front page of Thum states "first providing the core with a shell of heat-foamable material" (lines 6-7). Thum contains no disclosure or teaching regarding the forming or producing of the shell or the structural relationship between the core and the shell. Consequently, there is no disclosure or suggestion in Thum of a process step of **coating** a solid core material with activatable material, as recited in claim 1.

In the second and third paragraphs on page 4 of the Office action, after referring to claim 16 in the forgoing paragraph, the Examiner stated:

Thum fails to teach passing the assembly to a corrosion treatment bath subjecting all interior areas to a corrosion protection agent and passing the assembly to a drying oven for initiating foaming of the activatable material and filling the cavity with the activatable material. However, Russell teaches passing the assembly to a corrosion treatment bath subjecting all interior areas to a corrosion protecting agent (page 2, lines 9-10) and passing the assembly to a drying oven for initiating foaming of the activatable material and filling the cavity with the activatable material (page 2, lines 9-10) for the purpose of electrocoating and strengthening the hollow member.

The examiner deems the electrocoating as a corrosion-protection agent.

It is assumed by Applicant that the above-noted comments by the Examiner are also intended for the rejection of independent claims 1 and 15.

Russell states on page 2, lines 10-12, "electrocoat application used on most modern vehicles. In conventional modern auto finishing the body is given a total dip electocoat followed by ... a baking oven". If the **vehicle** body is given a total dip this does not mean that any **hollow** bodies of the vehicle body are also given a "total dip electocoat".

Russell states on page 2, lines 23-25, "[t]he use of zinc in the foam may also provide a measure of galvanic protection against corrosion of *steel* substrate *surfaces*" (emphasis added) and on page 2, lines 27-28, "the cured foam produced is a closed cell foam. This provides for improved corrosion protection of the *metal surfaces*" (emphasis added).

On page 4, lines 9-18, Russell states "[w]hen introduced into the electrocoat oven, the cartridge [containing the foaming means and plastics material] ... melts and the mixture therein escapes into the hollow member ... the mixture ... obtains intimate contact and adhesion with the walls even if they are *oily* from earlier processing or storage." (emphasis added).

Applicant also disagrees with the Examiner's assertion that "[t]he examiner deems the electrocoating [of *Russell*] as a corrosion-protection agent." Electrocoating a car body with paint in an "auto finish", as disclosed in *Russell*, is a different process at a different stage serving a different purpose than "passing [an] assembly to a corrosion treatment bath" as recited in the claims of the instant application. Consequently, it is believed that electrocoating a car body with paint cannot, by itself, be equated with applying a corrosion-protection agent.

Hence, *Russell* does **not** disclose a process step where the assembly is passed to a corrosion treatment bath subjecting **all interior** areas of the assembly to a corrosion protection agent, as recited in the claims. To the contrary, *Russell* teaches away from subjecting the interior areas of the assembly to a corrosion treatment.

To recap the above-discussed factual findings of Applicant in a nutshell, there is no disclosure or suggestion of a

- process step of **coating** a solid core material with activatable material in *Thum*,
- **corrosion treatment bath** subjecting **all interior** areas of the assembly in *Russell*.

Furthermore, *Russell* uses a "foaming means and plastics material" where "the foaming means causes the plastic material, which is in **liquid** form ..., to foam" (page 1, lines 24-25) (emphasis added). Hence, *Russell* does not disclose the method step of coating a **solid** core material with activatable material. Instead, in *Russell* the "foaming means and plastics material" are subjected to a "first elevated temperature, to foam and fill ... the hollow member and adhere to the inside wall". (page 1, lines 25-26). Subsequently, a second temperature higher than the first temperature is applied to cause the foamed material to set (page 1, lines 26-27).

According to MPEP §2143 (8th edition) in order to establish a *prima facie* case of obviousness by modifying or combining reference teachings there must be some suggestion or motivation with a reasonable expectation of success found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Considering the differences between *Thum* and *Russell* there is no such suggestion or motivation to combine *Thum* and *Russell*.

The underlying inventive concept of the invention of the instant application is to provide a production method for a hollow section wherein a corrosion protection medium can reach all areas of the hollow section. As discussed above, neither *Thum* nor *Russell* disclose or suggest applying a corrosion protection medium to the interior areas of a hollow section. Therefore, the invention as recited in claims 1 and 15 of the instant application is believed not to be obvious over *Thum* in view of *Russell*.

It is accordingly believed to be clear that *Thum* in view of *Russell* do not suggest the features of claims 1 and 15. Claims 1 and 15 are, therefore, believed to be patentable over the art and since claims 2-14 and 16-18 are ultimately dependent on claims 1 and 15, respectively, they are believed to be patentable as well.

It is respectfully pointed out that in the Office action dated May 4, 2001,

- claims 1-5, 7, 9 and 12-16 have been rejected as being anticipated by *Thum* (US 5,194,199);
- claims 6, 8, 10, 11, and 17-18 have been rejected as being obvious over *Thum* in view of *Russell* (WO 93/05103);

In the Office action dated October 24, 2001,

- claims 1, 6, 8, 10-11, and 13 have been rejected as being anticipated by *Russell* (WO 93/05103);
- claims 2-5, 7, 9, and 15-18 have been rejected as being obvious over *Russell* in view of *Thum* (US 5,194,199);
- claims 12 and 14 have been rejected as being obvious over *Russell*.

Finally, in the Office action dated January 24, 2002,

- claims 1-18 have been rejected as being obvious over *Thum* (US 5,194,199) in view of *Russell* (WO 93/05103).

As can be seen, the Examiner applied the references *Thum* and *Russell* alone or in all perceivable combinations. In the *Notice of References Cited* the Examiner only cited these two references. Applicant objects to being subjected to piecemeal

prosecution, as outlined above. Therefore, the Examiner is requested either to make a new search or to place the application in condition for allowance.

In view of the foregoing, reconsideration and allowance of claims 1-18 are solicited.

Please charge any fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,



For Applicant

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